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| APPLICATION NO. | FILING DATE      | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. CONFIRMATION NO. |               |
|-----------------|------------------|----------------------|--------------------------------------|---------------|
| 10/584,050      | 06/08/2007       | Tak-Kyu Kim          | 069576-0086 4606                     |               |
|                 | 7590             | EXAMINER             |                                      |               |
| 600 13TH STR    | EET, N.W.        | KOLLIAS, ALEXANDER C |                                      |               |
| WASHINGTO       | N, DC 20005-3096 |                      | ART UNIT                             | PAPER NUMBER  |
|                 |                  |                      | 1796                                 |               |
|                 |                  |                      |                                      |               |
|                 |                  |                      | MAIL DATE                            | DELIVERY MODE |
|                 |                  |                      | 02/05/2009                           | PAPER         |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| Office Action Summary  |   | Application        | on No.   | Applicant(s)        |             |  |  |  |
|--|---|--------------------|--|---------------------|-------------|--|--|--|
|  |   | 10/584,05          | 0  | KIM ET AL.          |             |  |  |  |
|  |   | Examiner           |  | Art Unit            |             |  |  |  |
|  |   | ALEXAND            | ER C. KOLLIAS  | 1796                |             |  |  |  |
| Period fo  | The MAILING DATE of this communication Reply  | on appears on the  | cover sheet with the c   | correspondence ad   | ddress      |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). |   |                    |  |                     |             |  |  |  |
| Status   |   |                    |  |                     |             |  |  |  |
| 1) 又   | Responsive to communication(s) filed or   | n 05 November 2    | 202  |                     |             |  |  |  |
| •  |   | ☐ This action is n |  |                     |             |  |  |  |
| 3)   | <i>'</i> —  | <del>_</del>       |  | osecution as to the | e merits is |  |  |  |
| ٥,١  | Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. |                    |  |                     |             |  |  |  |
| Dispositi  | on of Claims  |                    |  |                     |             |  |  |  |
| -<br>4)⊠   | Claim(s) 1-8 is/are pending in the applica  | ation.             |  |                     |             |  |  |  |
| ,  | 4a) Of the above claim(s) is/are withdrawn from consideration.  |                    |  |                     |             |  |  |  |
|  |   |                    |  |                     |             |  |  |  |
|  | 5) Claim(s) is/are allowed. 6) Claim(s) <u>1-8</u> is/are rejected.   |                    |  |                     |             |  |  |  |
| · ·  | Claim(s) is/are rejected.  Claim(s) is/are objected to.   |                    |  |                     |             |  |  |  |
| -  | Claim(s) are subject to restriction   | and/or election re | equirement   |                     |             |  |  |  |
|  |   | and/or election is | equirement.  |                     |             |  |  |  |
| Applicati  | on Papers   |                    |  |                     |             |  |  |  |
| •  | The specification is objected to by the Ex  |                    |  |                     |             |  |  |  |
| 10)  | The drawing(s) filed on is/are: a)[   | accepted or b)     | objected to by the l   | Examiner.           |             |  |  |  |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  |   |                    |  |                     |             |  |  |  |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).   |   |                    |  |                     |             |  |  |  |
| 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.   |   |                    |  |                     |             |  |  |  |
| Priority ι   | ınder 35 U.S.C. § 119   |                    |  |                     |             |  |  |  |
| <ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>  |   |                    |  |                     |             |  |  |  |
| 2) 🔲 Notic<br>3) 🔯 Infori  | t(s) e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-9 nation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date 20080806.  | 48)                | 4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal F 6) Other: | ate                 |             |  |  |  |
|  |   |                    |  |                     |             |  |  |  |

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### **DETAILED ACTION**

1. All outstanding objections and rejections, except for those maintained below, are

withdrawn in light of applicant's amendment filed on 11/5/2008.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior office action.

3. The new grounds of rejection set forth below are necessitated by applicant's amendment

filed on 11/05/2008. In particular, original Claim 1, 4-5, and 7-8 have been amended to recite

limitations not previously presented. Specifically, the above amended claims now recite "[f]or

producing a shaped article directly in contact with diesel having sulfur compounds or gasoline

fuel that causes the decomposition of the polyoxymethylene". Thus, the following action is

properly made final.

4. It is noted that the amended or substitute parts of Specification submitted with

amendment filed 11/5/2008is not in the proper format, see MPEP 714.I.B.

## Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode

contemplated by the inventor of carrying out his invention.

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6. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claims 1, 4-5, and 8 recite "a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel". Page 3, Lines 18-22 and Page 5 Liens 4-10 of the Specification discloses POM composition having high resistance to aggressive gasoline fuel and diesel fuel having a large content of sulfur compounds. As the Specification does not explicitly disclose "a shaped article directly in contact with diesel or gasoline fuels", there is no support for the article in direct contact with the afore mentioned fuels as presently claimed.

### Claim Rejections - 35 USC § 103

- 8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 9. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222).

The rejection is adequately set forth in paragraph 5 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

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Regarding the new limitation recited in claim 1, Mitsuuchi et al does not disclose the limitation "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene"

The recitation in the claims that the polyoxymethylene composition "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene" is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Mitsuuchi et al discloses a polyoxymethylene compositions as presently claimed, it is clear that the composition of Mitsuuchi would be capable of performing the intended use, i.e. ["f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene", presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

10. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222) as applied to claims 1-2 above and in view of Anada (5,777,019).

The rejection is adequately set forth in paragraph 6 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

11. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222) as applied to claims 1-2, in view of Kurz et al (US 6,489,388).

Regarding claims 4 and 7, Mitsuuchi teaches all the claim limitations as set forth above. However, the reference does not disclose a shaped article directly in constant with gasoline fuel able to cause the decomposition of polyoxymethylene.

Kurz et al discloses molded articles such as fuel lines, fuel tanks etc that a in direct contact with diesel or gasoline (Abstract, Column 3, Lines 31-36). The reference discloses molded articles polyoxymethylene as well as polyacetal stabilizers such as stearate salts and fillers (Column 2, Lines 44-53). The reference discloses that diesel fuels comprising sulfur compounds oxidize to give acidic sulfur which decomposes polyoxymethylene compositions (Column 1, Lines 22-33). The discloses polyoxymethylene molded articles and composition disclosed have improved toughness in terms of resistance to fuels (Column 1, Lines 44-52).

Given that both Mitsuuchi et al and Kurz et al are drawn to articles and compositions containing polyoxymethylene resin, fillers and stearate salts, in light of the particular advantages provided by the use and control of the polyoxymethylene resin as taught by Kurz, it would therefore have been obvious to one of ordinary skill in the art to modify the composition taught

by Mitsuuchi et al to include the polyoxymethylene compositions taught by Kurz to articles which are for direct contact with gasoline or diesel with a reasonable expectation of success.

12. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222) and Anada (5,777,019) as applied to claims 3 and 6 above and in view of Kurz et al (US 6,489,388).

Regarding claim 5 and 6, modified Mitsuuchi teaches all the claim limitations as set forth above. However, Mitsuuchi et does not disclose a shaped article produced from polyoxymethylene that is in direct contact with diesel having sulfur compounds or gasoline fuel that cause the decomposition of polyoxymethylene.

Kurz et al discloses molded articles such as fuel lines, fuel tanks etc that a in direct contact with diesel or gasoline (Abstract, Column 3, Lines 31-36). The reference discloses molded articles polyoxymethylene as well as polyacetal stabilizers such as stearate salts and fillers (Column 2, Lines 44-53). The reference discloses that diesel fuels comprising sulfur compounds oxidize to give acidic sulfur which decomposes polyoxymethylene compositions (Column 1, Lines 22-33). The discloses polyoxymethylene molded articles and composition disclosed have improved toughness in terms of resistance to fuels (Column 1, Lines 44-52).

Given that both Mitsuuchi et al and Kurz et al are drawn to articles and compositions containing polyoxymethylene resin, fillers and stearate salts, in light of the particular advantages provided by the use and control of the polyoxymethylene resin as taught by Kurz, it would therefore have been obvious to one of ordinary skill in the art to modify the composition taught

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by Mitsuuchi et al to include the polyoxymethylene compositions taught by Kurz to articles which are for direct contact with gasoline or diesel with a reasonable expectation of success

13. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al (KR 10-2003-0048733, see attached pages of previous Office Action for translation).

The rejection is adequately set forth in paragraph 7 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

Regarding the new limitation recited in claim 1, Lim et al does not disclose the limitation "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene"

The recitation in the claims that the polyoxymethylene composition "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene" is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Lim et al discloses a polyoxymethylene compositions as presently claimed, it is clear that the composition

of Lim et al would be capable of performing the intended use, i.e. ["f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene", presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

14. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al (KR 10-2003-0048733, see attached pages for translation) as applied to claims 1-2 above and in view of Anada (5,777,019).

The rejection is adequately set forth in paragraph 8 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

15. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,191,006).

The rejection is adequately set forth in paragraph 9 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

Regarding the new limitation recited in claim 1, Matsumoto et al does not disclose the limitation "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene"

The recitation in the claims that the polyoxymethylene composition "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene" is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to

determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Lim et al discloses a polyoxymethylene compositions as presently claimed, it is clear that the composition of Matsumoto et al would be capable of performing the intended use, i.e. ["f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuel that causes the decomposition of polyoxymethylene", presently claimed as required in the above cited portion of the MPEP, and thus, one of ordinary skill in the art would have arrived at the claimed invention.

16. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,191,006) as applied to claims 1-2 above and in view of Anada (5,777,019).

The rejection is adequately set forth in paragraph 10 of the Office Action mailed on 8/5/2008 and is incorporated here by reference.

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# Response to Arguments

17. Applicant's arguments filed 11/5/2008 have been fully considered but they are not persuasive.

- 18. The obviousness-type double patenting rejections set forth in Paragraphs 11-19 in the previous Office Action are withdrawn.
- 19. Applicant argues that Mitsuuchi et al as applied to claims 1-2 does not disclose that magnesium stearate is added to POM composition in order to improve flue resistance against diesel having sulfur compounds. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium and antioxidant as claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPO 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 5, as amended claim 1 recites intended use.

Specifically claim 1 recited "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuels that causes decomposition of polyoxymethylene".

Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation

serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

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- 20. Applicant argues that Mitsuuchi et al does not disclose a shaped articles directly in constant with diesel having sulfur compounds or gasoline fuel able to cause the decomposition of polyoxymethylene" as recited in claims 4 and 7. the deficiencies of Mitsuuchi et al is remedied by Kurz et al in the rejections set forth in Paragraph 7 above.
- 21. Applicant argues that Mitsuuchi in view of Anada as applied to claims 3 and 6 does not disclose a POM resin that provides molded articles that directly contacts fuels such as gasoline or diesel. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium, antioxidant, and filler as presently claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiava, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 5, as amended claim 1 recites intended use. Specifically "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuels that causes decomposition of polyoxymethylene". Applicants

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attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

- 22. Applicant argues that Mitsuuchi et al in view of Anada et al does not discloses a shaped articles directly in constant with diesel having sulfur compounds or gasoline fuel able to cause the decomposition of polyoxymethylene" as recited in claims 5 and 8. The deficiencies of Mitsuuchi et al is remedied by Kurz et al in the rejections set forth in Paragraph 8 above.
- 23. Applicant argues that Lim et al as applied to claims 1-2 does not disclose that magnesium stearate is added to POM composition in order to improve flue resistance against diesel having sulfur compounds. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium and antioxidant as claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 9 amended claim 1 recites intended use.

Specifically, claim 1 recites "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuels that causes decomposition of polyoxymethylene".

Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

24. Applicant argues that Lim in view of Anada as applied to claims 3 and 6 does not disclose a POM resin that provides molded articles that directly contacts fuels such as gasoline or diesel. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium, antioxidant, and filler as presently claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 9, as amended claim 1 recites intended use. Specifically "[f]or producing a shaped article directly in contact with diesel having sulfur

compounds or gasoline fuels that causes decomposition of polyoxymethylene". Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

25. Applicant argues that Matsumoto as applied to claims 1-2 does not disclose that magnesium stearate is added to POM composition in order to improve flue resistance against diesel having sulfur compounds. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium and antioxidant as claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 11 amended claim 1 recites intended use.

Specifically, claim 1 recites "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuels that causes decomposition of polyoxymethylene".

Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must

be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

26. Applicant argues that Matsumoto in view of Anada as applied to claims 3 and 6 does not disclose a POM resin that provides molded articles that directly contacts fuels such as gasoline or diesel. However, it is noted that given that the reference discloses the composition as claimed, including amounts of magnesium, antioxidant, and filler as presently claimed, the composition would inherently have resistance to diesel or gasoline fuels comprising sulfur.

Furthermore, it is noted that, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPO 58, 60 (Bd. Pat. App. & Inter. 1985).

Finally, as set forth above in Paragraph 9, as amended claim 1 recites intended use. Specifically "[f]or producing a shaped article directly in contact with diesel having sulfur compounds or gasoline fuels that causes decomposition of polyoxymethylene". Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to

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limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use.

### Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)-270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./ Examiner, Art Unit 1796

/Vasu Jagannathan/ Supervisory Patent Examiner, Art Unit 1796